

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Graeme John Proudler

Patent Application No.: 10/643,306

Filed: 8/18/2003

For: " Method of controlling the
processing of data"

) On Appeal to the

) Board of Appeals

)

) Group Art Unit: 2135

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) Examiner: Dada, B. W.

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) Date: July 16, 2008

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REPLY BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This is a Reply Brief filed pursuant to 37 CFR 41.41 in an Appeal taken from the Final Rejection, dated October 19, 2007, for the above identified patent application. A Notice of Appeal was filed on January 18, 2008 and an Appeal Brief was filed on March 18, 2008. The Examiner's Answer is dated May 16, 2008. Appellants submit that this Reply Brief is being timely filed on July 16, 2008.

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1. Is it obvious to combine the teachings of Raley and Ishizaki?

As stated in Applicant's Appeal Brief, 35 U.S.C. § 103 "forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The Court stated that obvious analysis "should be made explicit." *Id.* at 1740-41, citing *In re Kahn*, 441 F.3d 977,988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

The Examiner asserts in his answer that "it could have been obvious ... to logically group a set of data items as taught by Ishizaki and employ that data items of Raley to achieve the predictable result of grouped based controlling of data." [Pg. 3, ll. 14-17]

The Applicant took issue with this assertion in the Appeal Brief. The Examiner responds by discussing the breadth of applicant's claims [pg. 6, ll. 18-19] and the fact that Applicant made an argument not supported by the claim language. [pg 7, ll. 1-4].

The Examiner's argument misses the point. The Examiner should not be looking at applicant's claims to come up with "some articulated reasoning with some rational underpinning to support" combining the teachings of Ishizaki and Raley. It is as if the Examiner is looking to Applicant's own disclosure to justify combining Ishizaki and Raley. That is improper. The Examiner must look to the prior art to justify combining

Ishizaki and Raley. That the Examiner has not done in the manner required by KSR cited above.

The observations which Applicant made on page 7 of the Appeal Brief regarding why a person skilled in the art would not be motivated to combine Ishizaki and Raley are merely dismissed by the Examiner as not appearing in the claims. Given the fact that the Examiner does not attack these arguments head on, it must be that these arguments are directly on point. Whether or not these arguments appear in the claims is a red herring issue raised by the Examiner in the Answer.

The Applicant has pointed out why it is believed that it would not be obvious to combine the teachings of Ishizaki and Raley. The Examiner responds by (i) dismissing Applicant's arguments as not appearing in the claims and (2) reaffirming his conclusory statements about "the predictable result of grouped based controlling of data" whatever that is supposed to mean.

If it is not obvious to combine Ishizaki and Raley in some logical manner, then the issue of the breadth and contents of Applicant's claims need not be addressed. Instead the Examiner tries to use Applicant's claims as justification for combining Ishizaki and Raley and for dismissing Applicant's arguments why it would not be obvious to combine these two references. The Examiner should be looking solely at the prior art when he tries to meet the KSR test for combining references.

If it is obvious to combine the teachings of Raley and Ishizaki, then do they teach each and every limitation of the claims?

Claims 1, 43 and 50 each include a limitation along the following lines: “applying individualised usage rules to each of the data items based on a measurement of integrity of a computing entity to which the data items are to be made available”. The Examiner asserts that documents are individualized in Raley. That is well and fine, but the claims language is still not met! The Examiner states that different rights are attached to different documents in Raley. But the claim language recites “ applying individualised usage rules to each of the data items based on a measurement of integrity of a computing entity to which the data items are to be made available”. There is no “measurement of integrity of a computing entity” as claimed (Raley checks the browser, not the computing entity) and there is no connection between Raley’s documents and the “integrity of a computing entity”. The Examiner refers to paragraphs 0050-0054 of Raley, but Raley is concerned with the identity of the user and whether they have paid the requisite fees or viewing and/or printing. These rights have nothing to do with the “measurement of integrity of a computing entity” as claimed!

Independent claim 33 recites “a set of logically related data items, each data item in the set having a rule associated therewith, said rules acting to individually define usage and/or security to be observed when processing each of the data items in the set of data items, and in which forwarding of the set of data items is performed in accordance with mask means provided in association with the rules.”

The Applicant asks in the Appeal Brief “how is a ‘set of data items’ supposed to be defined based on Raley? Since the Examiner reads the limitation ‘data item’ on Raley’s documents/webpages, how is a ‘set’ ever formed? Where does ‘processing each of the

data items in the set of data items' occur in Raley?" [Appeal Brief, pg. 10, ll. 5-8]. No response by the Examiner can be found where he addresses Applicant's arguments. See pg. 8 of the Answer. It appears that the Examiner believes that this claim language can just be ignored. That is not correct.

Summary

- The Examiner has not made an appropriate case for combining the teachings of Ishizaki and Raley in the manner required by KSR.
- Even if the Examiner could overcome Applicant's arguments why is does not make sense to combine the teachings of Ishizaki and Raley (and meet the requirements of KSR in this regard -- which he hasn't), the claims are not anticipated by the combination suggested by the Examiner.

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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this Appeal Brief is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office on

16 July 2008

(Date of Transmission)

Stacey Dawson

(Name of Person Transmitting)

/Stacey Dawson/

(Signature)

16 July 2008

(Date)

Respectfully submitted,

/ Richard P. Berg /

Richard P. Berg
Attorney for the Applicant
Reg. No. 28,145
LADAS & PARRY
5670 Wilshire Boulevard,
Suite 2100
Los Angeles, California 90036
(323) 934-2300 voice
(323) 934-0202 facsimile